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AS

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.
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09/131,744 08/10/98 KOITABASHI

N 884.2742

005514 IM22/0410
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EXAMINER

GRENDZYNSKI, M

ART UNIT

PAPER NUMBER

1774

16

DATE MAILED:

04/10/01

Please find below and/or attached an Office communication concerning this application or proceeding.

Commissioner of Patents and Trademarks

Office Action Summary

Application No.

09/131,744

Applicant(s)

Koltabashi et al.

Examiner

Grendzynski, Michael E.

Group Art Unit

1774



☒ Responsive to communication(s) filed on Feb 23, 2001

☒ This action is **FINAL**.

☐ Since this application is in condition for allowance except for formal matters, **prosecution as to the merits is closed** in accordance with the practice under *Ex parte Quayle*, 35 C.D. 11; 453 O.G. 213.

A shortened statutory period for response to this action is set to expire 3 month(s), or thirty days, whichever is longer, from the mailing date of this communication. Failure to respond within the period for response will cause the application to become abandoned. (35 U.S.C. § 133). Extensions of time may be obtained under the provisions of 37 CFR 1.136(a).

Disposition of Claim

☒ Claim(s) 1-10 is/are pending in the application

Of the above, claim(s) 8, 9/2, and 10 is/are withdrawn from consideration

☐ Claim(s) _____ is/are allowed.

☒ Claim(s) 1-7 and 9/1 is/are rejected.

☐ Claim(s) _____ is/are objected to.

☐ Claims _____ are subject to restriction or election requirement.

Application Papers

☐ See the attached Notice of Draftsperson's Patent Drawing Review, PTO-948.

☐ The drawing(s) filed on _____ is/are objected to by the Examiner.

☐ The proposed drawing correction, filed on _____ is ☐ approved ☐ disapproved.

☐ The specification is objected to by the Examiner.

☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. § 119

☐ Acknowledgement is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d).

☐ All ☐ Some* ☒ None of the CERTIFIED copies of the priority documents have been

☐ received.

☐ received in Application No. (Series Code/Serial Number) _____

☐ received in this national stage application from the International Bureau (PCT Rule 17.2(a)).

*Certified copies not received: _____

☐ Acknowledgement is made of a claim for domestic priority under 35 U.S.C. § 119(e).

Attachment(s)

☐ Notice of References Cited, PTO-892

☐ Information Disclosure Statement(s), PTO-1449, Paper No(s). _____

☐ Interview Summary, PTO-413

☐ Notice of Draftsperson's Patent Drawing Review, PTO-948

☐ Notice of Informal Patent Application, PTO-152

— SEE OFFICE ACTION ON THE FOLLOWING PAGES —

Art Unit: 1774

DETAILED ACTION

Election/Restriction

1. Newly submitted claim 10 is directed to an invention that is independent or distinct from the invention originally claimed for the following reasons: The newly submitted claim is directed to an apparatus. The apparatus as claimed can be used to practice another and materially different process, e.g., a process in which two ink materials (and no processing liquid) are applied. (MPEP § 806.05(e)).

Since applicant has received an action on the merits for the originally presented invention, this invention has been constructively elected by original presentation for prosecution on the merits. Accordingly, claim 10 is withdrawn from consideration as being directed to a non-elected invention. See 37 CFR 1.142(b) and MPEP § 821.03.

Specification

2. A substitute specification excluding claims is required pursuant to 37 CFR 1.125(a) because the interlineations or cancellations made in the specification or amendments to the claims could lead to confusion and mistake during the issue and printing processes.

A substitute specification filed under 37 CFR 1.125(a) must only contain subject matter from the original specification and any previously entered amendment under 37 CFR 1.121. If the substitute specification contains additional subject matter not of record, the substitute specification must be filed under 37 CFR 1.125(b) and must be accompanied by: 1) a statement that the substitute specification contains no new matter; and 2) a marked-up copy showing the amendments to be made via the substitute specification relative to the specification at the time the substitute specification is filed.

Art Unit: 1774

Response to Arguments

3. Applicant's arguments filed 3/6/01 have been fully considered but they are not persuasive.

Claim Rejections - 35 U.S.C. § 112

4. Claims 1-7 and 9/1 remain rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention. Applicants argue that the phrase "processing liquid" is not ambiguous "since one of ordinary skill in the art would know what is meant by this term." It remains the examiner's position that this phrase does not have a well-defined meaning in the art, and that, as applicants define the phrase, it includes only processing liquids that are achromatic. It is suggested that applicants provide evidence of the known meaning for this phrase, as it is understood in the art.

Claim Rejections - 35 U.S.C. § 103

5. Claim 1 remains rejected under 35 U.S.C. 103(a) as being unpatentable over Shioya or Yokoi for the reasons of record. Applicants argue that the cited references do not show that proper selection of the ink K_a and processing liquids K_a can produce a smear-resistant, high-density image. This argument is not found persuasive because where the general conditions of a claim are disclosed in the prior art, it is not inventive to discover workable ranges by routine experimentation, absent unexpected results. *In re Aller*, 220 F.2d 454, 456 (1955). Both Shioya and Yokoi disclose the general conditions of instant claims, as stated in the Office Action of August, 2000. Prevention of bleeding by controlling rates of diffusion, moreover, is a *conventional concern in the art*. Its ability to control bleeding would be readily appreciated by one skilled in the art. It is recommended that applicants provide further evidence distinguishing the instant invention over the prior art.
6. For similar reasons, claims 1-7 and 9/1 remain rejected under 35 U.S.C. 103(a) as being unpatentable over Shioya or Yokoi, as applied to claim 1, above, in further view of Inui, for the reasons of record.

Art Unit: 1774

Conclusion

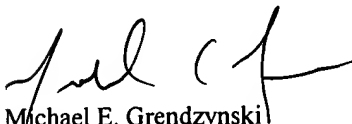
7. **THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

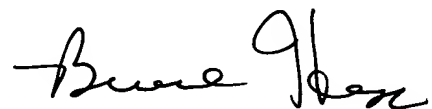
A shortened statutory period for reply to this final action is set to expire **THREE MONTHS** from the mailing date of this action. In the event a first reply is filed within **TWO MONTHS** of the mailing date of this final action and the advisory action is not mailed until after the end of the **THREE-MONTH** shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than **SIX MONTHS** from the mailing date of this final action.

8. Should you have any questions concerning this communication, please direct them to Michael E. Grendzynski at telephone number (703) 305-0593. The examiner can be reached at this number from 7:00 a.m. to 3:30 p.m. Monday-Friday. If attempts to reach the examiner by telephone prove unsuccessful, the examiner's supervisor, Cynthia Kelly, can be reached at (703) 308-0449. Please allow the examiner twenty-four hours to return your call.

A facsimile center has been established for Group 1700 on the 8th floor of Crystal Plaza 3. The hours of operation are Monday through Friday, 8:45 am to 4:45 pm. The fax numbers for Art Unit 1774 are (703) 305-3599 for official after final faxes, and (703)305-5408 for all other official faxes. Use of the Group 1700 center will facilitate rapid delivery of materials to examiners in Art Unit 1774.

Any inquiry of a general nature, or those relating to the status of this application should be directed to the group receptionist whose telephone number is (703) 308-2351.


Michael E. Grendzynski
Assistant Examiner
April 5, 2001



BRUCE H. HESS
PRIMARY EXAMINER